

REMARKS

Claims 14-26 are all the claims pending in the application. Claim 14 has been amended based on, for example, pages 28-29 and the Examples of the specification. Additionally, claim 14 has been amended to incorporate the subject matter of claim 1, which has been canceled. Further, new claims 18-26 have been added and correspond to claims 2, 5 and 7-13, which have been canceled. Further, the claims have been amended to change the preamble, to depend from claim 14, and/or for purposes of clarity.

Entry of the above amendments is respectfully requested.

I. Response to Nonstatutory Obviousness-type Double Patenting Rejection

Claims 1-17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10/501,401 in view of Yoneyama et al. (US 5,362,482).

Applicants may wish to traverse the rejection.

The Examiner relies on the disclosure of US '401 and asserts that ultraviolet protective powders are disclosed at [0050] and in the Examples.

However, when considering whether the present invention would have been an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. Thus, in this case, the Examiner cannot rely on the disclosure of US '401 and that based on the claims of US '401, one of ordinary skill in the art would not consider the use of ultraviolet protective powders.

Accordingly, it is submitted that the present claims are not rendered obvious by the claims of US '401.

In addition, as discussed below, copending application '401 discloses a composition for a cosmetic product but does not disclose a composition for a cosmetic raw material (i.e., an ultraviolet protective preparation as a cosmetic raw material). That is, the water-in-oil preparation of copending application '401 is a cosmetic product, and not a raw material for producing a cosmetic product.

Further, as discussed below, Yoneyama also fails to disclose an ultraviolet protective preparation as a cosmetic raw material.

Accordingly, it is submitted that the present claims are not obvious in view of the claims of copending application '401 alone or in view of Yoneyama.

For at least the above reasons, withdrawal of the obviousness-type double patenting rejection is respectfully requested.

II. Response to Rejection of Claims 1-8 and 12-16 under 35 U.S.C. § 103(a)

Claims 1-8 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoneyama et al. (US 5,362,482) in view of Suzuki (US 6,759,052).

Applicants respectfully traverse the rejection.

Claim 14 is directed to a method for producing a cosmetic comprising a step of adding 3 to 95% by weight of an ultraviolet protective preparation comprising 0.2 to 3% by weight of an ester compound, 52 to 79.9% by weight of an ester oil and 15 to 45% by weight of an ultraviolet protective powder, wherein the ester compound is an ester compound produced from glycerin, behenic acid and eicosanic diacid and the ester oil is an oil agent which has a liquid or paste form at normal temperature and is one or more ester oils prepared from one or more polyols selected from neopentyl glycol, 2-methyl-2-ethyl-1,3-propanediol, glycerin,

trimethylolpropane, diglycerin, ditrimethylolpropane, erythritol and pentaerythritol and one or more saturated straight-chain carboxylic acids having a monovalent carboxyl group and/or saturated branched carboxylic acids having a monovalent carboxyl group.

It is submitted that Yoneyama, alone or in combination with Suzuki, fails to disclose, teach or suggest a ultraviolet protective preparation as a raw material that is used to prepare a cosmetic. That is, Yoneyama discloses a cosmetic preparation but does not disclose, teach or suggest an ultraviolet protective preparation, preparing the same separately prior to formation of the cosmetic, or the steps of preparing the cosmetic using the ultraviolet protective preparation. Thus, Yoneyama fails to teach or suggest the method of the present invention according to claim 14.

In addition, Suzuki does not make up for the deficiencies of Yoneyama.

Furthermore, it is submitted that the use of a separately prepared ultraviolet protective preparation provides unexpectedly superior results. To demonstrate the unexpectedly superior results of the present invention, a Declaration under 37 C.F.R. § 1.132 of Mr. Makoto Matsuzawa is submitted herewith. Experiments were conducted comparing a cosmetic produced by the process of the present invention (i.e., preparing and using an ultraviolet protective preparation for cosmetic raw material) with a cosmetic produced without the separate preparation of an ultraviolet protective preparation beforehand. As can be seen from the results set forth at the bottom of Table 1, the evaluation of the UV cream of Example 16 produced by the claimed method were superior to the evaluation of the UV cream of Comparative Example 34, which was produced without using an ultraviolet protective preparation. Accordingly, the cosmetic prepared by the method of claim 14 resulted in

excellent dispersibility in an oil phase, transparent feel and extension.

In view of at least the foregoing, it is respectfully submitted that claim 11 is patentable over the cited art.

In addition, claims 15-26 depend from claim 14, and thus it is respectfully submitted that these claims are patentable for at least the same reasons as claim 14.

Withdrawal of the rejection is respectfully requested.

III. Response to Rejection of Claims 9-11 and 17 under 35 U.S.C. § 103(a)

Claims 9-11 and 17 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Yoneyama et al. (US 5,362,482) in view of Suzuki (US 6,759,052) and in further view of Miyoshi et al. (US 5,968,531).

Applicants respectfully traverse the rejection.

Claim 17 depends from claim 14, and thus it is respectfully submitted that claim 17 is patentable over the cited art for at least the same reasons as claim 14. Accordingly, withdrawal of the rejection is respectfully requested.

IV. Conclusion

In view of the above, reconsideration and allowance of claims 14-26 is respectfully requested.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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Respectfully submitted,



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